

### **Remarks/Arguments**

Claims 86-103 are now pending in this application. By this amendment, no claims have been cancelled and no new claims have been added. Claims 86, 92 and 98 have been amended. Following entry of this amendment, claims 86-103 will be pending in the present application. For the reasons set forth below, Applicants respectfully request reconsideration and immediate allowance of this application.

#### **I. Examiner Interview Summary**

The Applicants first wish to express their sincere appreciation for the time that Examiner Ouellette spent with Applicants' attorneys, Shabbi Khan and Jodi Hartman, during a telephone discussion on April 20, 2009, regarding the outstanding Office Action. During that conversation, the Applicants' attorneys discussed possible claim amendments regarding the independent claims. Although no agreement was reached, Applicants respectfully request that Examiner Ouellette carefully consider the claim amendments made in this response. Additionally, Examiner Ouellette suggested that Applicants file a Request for Continued Examination along with the response to the present Action.

#### **II. Claim Rejections Under 35 U.S.C. §112, First Paragraph**

Claims 86, 92, and 98 were rejected under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art the instant application at the time the application was filed. The Applicants have amended claims 86, 92, and 98 in an effort to address the Examiner's concerns. Accordingly, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph be withdrawn.

#### **III. Claim Rejections Under 35 U.S.C. §103 Over Hunter and Eggleston**

Claims 86-103 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,298,327 to Hunter et al. (hereinafter "*Hunter*") in view of U.S. Patent No. 6,061,660 to Eggleston et al. (hereinafter "*Eggleston*"). This rejection is respectfully traversed.

Independent Claim 86

Claim 86 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Applicants respectfully submit that the combined teachings of *Hunter* and *Eggleston* do not teach, suggest, or describe each and every recitation of claim 86. As amended, claim 86 recites, *inter alia*, that a program for tracking innovation disclosures by an organization as part of a system for managing protection and licensing of intellectual property assets comprises tracking the disclosure gifts and gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances. Support for this amendment can be found, e.g., on page 183, lines 7-10 of the specification of Applicants' patent application.

*Hunter* does not teach, suggest, or describe a program for tracking invention disclosures by an organization including the features recited by claim 1. On the contrary, *Hunter* describes a system that enables inventors to adequately disclose the characteristics of their invention to their technology manager and research sponsor, as well as their patent professional. Moreover, *Eggleston* describes a system for providing incentive programs over a computer network in which a host may provide sponsoring companies with the capability to buy prepackaged or self-built incentive programs. Although *Eggleston* mentions incentive programs for employees, *Eggleston* does not teach, suggest or describe gifts given to innovators for *at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances*. (emphasis added). Neither *Hunter* nor *Eggleston* teaches, suggests or describes a program for tracking invention disclosures by an organization including tracking gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances. Applicants respectfully submit that claim 86 is allowable over the combined teachings of *Hunter* and *Eggleston*. Therefore, Applicants respectfully request withdrawal of this rejection.

Independent Claim 92

Claim 92 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Applicants respectfully submit that the combined teachings of *Hunter* and *Eggleston* do not teach, suggest, or describe each and every recitation of claim 92. As amended, claim 92 recites, *inter alia*, that an apparatus for tracking innovation disclosures by an

organization as part of a system for managing protection and licensing of intellectual property assets comprises tracking the disclosure gifts and gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances. Since independent claim 92 includes recitations similar to claim 86, Applicants respectfully submit that claim 92 is also allowable over the combined teachings of *Hunter* and *Eggleston* at least for the reasons discussed above regarding claim 86. Therefore, Applicants respectfully request withdrawal of this rejection.

Independent Claim 98

Claim 98 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Applicants respectfully submit that the combined teachings of *Hunter* and *Eggleston* do not teach, suggest, or describe each and every recitation of claim 98. As amended, claim 98 recites, *inter alia*, that a method for tracking innovation disclosures by an organization as part of a system for managing protection and licensing of intellectual property assets comprises tracking the disclosure gifts and gifts given to the plurality of innovators for at least one of intellectual property asset filings, intellectual property asset publications, and intellectual property asset issuances. Since independent claim 98 includes recitations similar to claim 86, Applicants respectfully submit that claim 98 is also allowable over the combined teachings of *Hunter* and *Eggleston* at least for the reasons discussed above regarding claim 86. Therefore, Applicants respectfully request withdrawal of this rejection.

Claims 87-91, 93-97 and 99-103

Claims 87-91, 93-97 and 99-103 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hunter* in view of *Eggleston*. Applicants respectfully submit that claims 87-91, 93-97 and 99-103 are allowable because they include recitations not taught by the cited references and because these claims depend from allowable independent claims. Therefore, Applicants respectfully request withdrawal of these rejections.

**Conclusion**

In view of the foregoing amendment and remarks, Applicants respectfully submit that all of the pending claims in the present application are in condition for allowance. Reconsideration and reexamination of the application and allowance of the claims at an early date is solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact Applicants' undersigned attorney at 404.815.1900.

Respectfully submitted,

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Date: April 27, 2009

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